UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/604,000
Filing Date: June 25, 2003
Appellant(s): ASCHEN ET AL.

John R. Pivnichny

<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/14/2006 appealing from the Office action

mailed 4/4/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Publication Number 2002/0091782 issued to Benninghoff III

U.S. Patent Number 5,913,033 issued to Grout

U.S. Publication Number 2005/0114671 issued to Little et al

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Publication Number 2002/0091782 issued to Benninghoff III ("Benninghoff").

With respect to claim 10, Benninghoff discloses,

A system for providing data stored in a mailfile to an application, comprising:

a mailfile stored on a server (Figure 1 element 10), having data stored as

documents with sections (Figures 1 – 3, 7, and paragraph 12, 134);

a database for passing a request from an application running on a user

workstation (Figure 1 element 700 and 701: <u>recipient computer running outlook</u>), for one

of said documents to said mailfile and upon return of said one of said documents,

converting said one of said documents into an extended markup format (Figure 5, 11,

19, and paragraph 10 – 12, 134);

an authentication directory having authentication records for an application

(Figure 5,12, and paragraph 14, 43, 46, 55, 131); and

mail and calendaring web service (Figure 1 element 10, Figures 7 – 8, paragraph

56, et seq.) software running on a server different from said workstation, for receiving

said request from said application for a document (Figure 5, 19, and paragraph 134),

receiving text files in an extended markup format from said database, accessing binary

data from said mailfile, creating an object comprising the converted document with said

binary data inserted (Figure 5, 11, paragraph 10 – 12, 134), authenticating said

application using said directory (Figure 5,12, and paragraph 14, 43, 46, 55, 131), and

sending said object to said application (paragraph 9 – 12, 134).

With respect to claim 11, Benninghoff discloses said database and said software

run on different servers (Figure 1)

With respect to claim 12, Benninghoff discloses said extended markup format is

XML (paragraph 10 – 12, 134).

With respect to claim 13, Benninghoff discloses said software is adapted to

operate without the need of a mail or calendaring client (Figure 1, paragraph 9).

With respect to claim 14, Benninghoff discloses said software is adapted to

retrieve said sections of said document from said mailfile (Figure 2 – 3, 5, 7, and

paragraph 11 – 12, 134).

With respect to claim 15, Benninghoff discloses said binary data is an image file

(Figure 2 – 3, 5, 7: attachment could be an image file).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 – 4, 6 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Publication Number 2002/0091782 issued to Benninghoff III ("Benninghoff") in

view of U.S. Patent Number 5,913,033 issued to Grout ("Grout").

With respect to claim 1, Benninghoff discloses,

A method of providing data to an application, comprising the steps of:

providing a mailfile stored on a server (Figure 1 element 10), of documents

having a section and fields (Figure 2 – 3, 7, and paragraph 12, 134);

receiving a request from an application running on a user workstation different

from said server, for one of said documents (Figure 5, 19, and paragraph 134);

retrieving said fields of said one of said documents from said mailfile (Figure 5,

11, and paragraph 134);

in response to said fields, retrieving said one of said documents as a markup

language document (paragraph 10 – 12, 134);

sending said object to said application (paragraph 9 – 12, 134).

Benninghoff does not explicitly discloses,

inserting at said server, a URL into said markup language document to retrieve

said section of said one of said documents;

retrieving at said server, said section from said mailfile in said markup language;

removing at said server, said URL from the retrieved document.

However, Grout discloses,

inserting at said server (Figures 1A – 1B: "server" could be any computer. Client

computer document-server computer, and standard-set server computer in Grout all can

serve as the "server"), a URL into said markup language document to retrieve said

section of said one of said documents (Figures 2A – 2B, column 3 line 13 – 32, column

6 line 60 – 63);

retrieving at said server, said section from said mailfile in said markup language

(Figure 2A – 2B, column 3 line 13 – 32);

removing at said server, said URL from the retrieved document and creating an

object having said section expanded in the retrieved document (Figure 2A – 2B, column

5 line 45 – 61, column 6 line 60 – column 7 line 38: "removing" step is inherent and well-

known. In Grout, URL is automatically removed as the linked object is retrieved).

At the time of the present invention, it would have been obvious to a person of

ordinary skill in the data processing art to combine the two references because Grout's

method of inserting a URL and retrieving the designated section to replace the URL

would have enabled Benninghoff's method of providing data to an application to

increase the performance of browsing documents and allows downloading of

multimedia objects tailored for the user's language or culture (column 2 line 59 – 64).

With respect to claim 2, Benninghoff discloses said fields are retrieved as an

XML document (paragraph 10 – 12, 134).

With respect to claim 3, Grout discloses said markup language is HTML (column

5 line 45 – 61, column 6 line 60 to column 7 line 45)

With respect to claim 4, Benninghoff discloses said one of said documents has a

file attachment link (Figure 3 – 4, 7).

With respect to claim 6, Grout discloses said one of said documents has an

image tag (column 7 line 1 – 44).

With respect to claim 7, Grout discloses retrieving the image of said image tag,

encoding said image, and inserting the encoded image in place of said image tag in the

retrieved document (Figure 2A – 2B, column 6 line 60 to column 7 line 45).

With respect to claim 8, Grout discloses said one of said documents has a link to

other items in said document (Figure 2A – 2B, column 3 line 13 – 32).

With respect to claim 9, Grout discloses retrieving the content of said link, and

inserting said content in the retrieved document at the position of said link (Figure 2A –

2B, column 6 line 60 to column 7 line 45).

Claim 16 – 18 are essentially the same as claim 1 – 3 except they set forth the

limitations as "a computer system for exposing a mail and calendaring document to an

application" rather than "a method of providing data to an application", and therefore are

rejected for the same reasons as discussed in claim 1 – 3 rejections.

Claim 19 – 20 are essentially the same as claim 1 – 2 except they set forth the

limitations as "a computer product" rather than "a method", and therefore are rejected

for the same reasons as discussed in claim 1 – 2 rejections.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Benninghoff and Grout, further in view of U.S. Publication Number 2005/0114671

issued to Little et al ("Little").

Benninghoff and Grout discloses the method of claim 4 as discussed above in

claim 4 rejection.

Benninghoff and Grout do not explicitly indicate retrieving attachment, removing

said link, and inserting said attachment into said object.

However, Little discloses retrieving attachment, removing said link, and inserting

said attachment into said object (paragraph 76). At the time of the present invention, it

would have been obvious to a person of ordinary skill in the data processing art to

combine the aforementioned references because Little's method of embedding the

attachment into the body of the email message would have enabled Benninghoff and

Grout's method of providing data to an application to save user's effort and time needed

to open and store the attachment, by already displaying the attachment within the body

of the email message.

(10) Response to Argument

Appellant's arguments filed on 11/14/2006 have been fully considered but they

are not persuasive.

Appellant mainly argued:

1.   Regarding claim 10, there is no description of "a mailfile stored on a

server, having data stored as documents having sections" in Benninghoff.

2.   Regarding claim 10, there is no description of "calendaring web service

software," nor is there any description of "software on the server for creating an object

comprising the converted document with the binary data inserted" in Benninghoff.

3.   Regarding claim 1, Benninghoff does not describe a "section".

4.   Regarding claim 1, Grout does not describe a "server".

Examiner respectfully traverses Appellant's arguments for the following reasons:

1.   Benninghoff clearly discloses or suggests "a mailfile stored on a server

(Figure 1 elements 10 and 20: electronic package to be stored on a server), having data

stored as documents having sections (Figure 3: electronic package comprising fields,

text and messages (body of text could be a section), paragraph 134: standard eml file

(most commonly used message format on the internet) within the encrypted file, et

seq.). In response to appellant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which appellant relies

(i.e., anything related to twistees or any type of expansion controls) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2.   Benninghoff clearly discloses or suggests "calendaring web service software (Figure 1 element 10, Figure 4A element 154, Figure 7: server performs transaction logging (time and date) such as when to deliver/receive electronic packages or period of electronic package storage, et seq., Figure 8: it mentions that eml file can be automatically opened using Outlook Express so this Figure essentially teaches how the file in the electronic package can be opened using mail and calendaring software and perform various functions using the software, paragraph 56: setting time and manner of transmitting electronic package to a designated recipient, et seq.)," and "software on the server for creating an object comprising the converted document with the binary data inserted (paragraphs 10 – 12: Extensible Markup Language converter, et seq.)."

3.   Benninghoff clearly discloses of suggests a "section" in Figure 3 as explained above.

4.   The "server" in question is disclosed in Benninghoff as explained above. The steps performed including inserting, retrieving and removing URL are disclosed in Grout. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
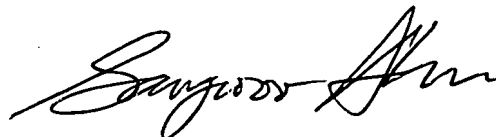
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

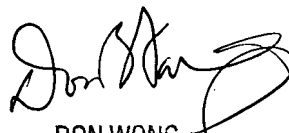For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Patent Examiner Sangwoo Ahn

Conferees:

Hosain Alam, Don Wong, Sangwoo Ahn

DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER